



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/197,435 11/23/98 LUPKE

M SJ-10317US

IM22/0330

DOUGLAS S JOHNSON
133 RICHMOND STREET WEST SUITE 301
TORONTO ON M5H 2L7
CANADA

AIR MAIL

EXAMINER

STAICOVICI, S

ART UNIT

PAPER NUMBER

1732

DATE MAILED:

03/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/197,435

Applicant(s)

LUPKE ET AL.

Examiner

Stefan Staicovici, PhD

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 November 1998 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) (submitted)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Amendment

1. Applicants' amendment filed January 19, 2001 (Paper No.5) has been entered. Claims 1-11 have been canceled. New claims 12-16 have been added.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested:
"METHOD OF MAKING A PIPE WITH COUPLING CONFORMING TO PIPE DIAMETER".

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference number "9a" is not shown in Figure 4 as described in the original disclosure on page 4, line 26. Correction is required.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: reference number "10" in Figure 4. Correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 12-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 12, line 1, the limitation of "multiple streams" does not appear to have support in the original disclosure. Although the original disclosure does appear to have support for "two streams" (page 3, line 9), the original disclosure does not appear to have support for the broader limitation of "multiple streams" which may include more than two streams. Claims 13-16 are rejected as dependent claims.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 12, the limitation of "multiple streams" is unclear as to the relationship between the "multiple streams" and the resulting first corrugations, second corrugation and the bowed wall. It should be noted that for the purpose of examination it has been assumed that the "multiple streams" form a composite pipe. Claims 13-16 are rejected as dependent claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukui *et al.* (US Patent No. 5,704,401).

Fukui *et al.* ('401) teach the basic claimed process for making a continuous plastic pipe from two (multiple) streams of plastic materials (col. 3, lines 25-40) including a first region having first corrugations (5), an intermediate region (2) (bowed wall region) and a second region having second corrugations (4), said second corrugations (4) having an outside diameter less than the outside diameter of said first corrugations (5). Further, Fukui *et al.* ('401) teach that said first region having said first corrugations (5), said second region having said second corrugations (4) and said intermediate region (2) are formed as a continuous wall with the intermediate region (2) positioned between said first region having said first corrugations (4) and said second region having said second corrugations (5) (see Figure 2 and col. 3, lines 47-63).

Regarding claim 12, Fukui *et al.* ('401) do not teach that the diameter of the intermediate region is the same as the diameter of said first region having said first corrugations (5). However, whether the diameter of said intermediate region (2) is the same as the outside diameter of said first region having said first corrugations (5) or said second region having said second corrugations (4) is a mere obvious matter of design choice. It would have been obvious for one

Art Unit: 1732

of ordinary skill in the art at the time of the invention to have provided an intermediate region (2) such that the outside diameter of said intermediate region (2) is the same as the outside diameter of said first region having said first corrugations (5) due to a variety of reasons such as design preferences, desired flexibility of the resulting molded pipe, etc.

In regard to claim 13, Fukui *et al.* ('401) teach that the intermediate region (2) includes a transitional wall which reduces the outside diameter between said first region having said first corrugations (5) and said second region having said second corrugations (4).

Allowable Subject Matter

11. Claims 14-16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

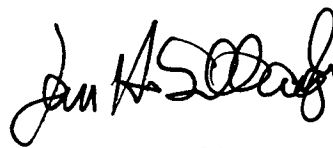
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-0396. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM and alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached at (703) 308-3829. The fax phone number for this

Art Unit: 1732

Group is (703) 305-7718. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


JAN H. SILBAUGH
SUPERVISORY PATENT EXAMINER
ART UNIT ~~1732~~ 1732
03/26/01

Stefan Staicovici, PhD



March 23, 2001